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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,439	07/27/2001	Robert G. Farris	EFTD-25,758	9711

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EXAMINER

DASS, HARISH T

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,439

Applicant(s)

FARRIS ET AL.

Examiner

Harish T. Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/01, 7/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the method claim 28 includes a word "said", it should be removed, fixed or the limitation should be clarified.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8, 24, 26-28, and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Brody et al (hereinafter Brody –US 5,350,906).

Re. Claim 1, Brody discloses depositing an article having a monetary value in a device at the origin [Abstract; col. 6 lines 16-24; col. 2 lines 43-66];

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electronically communicating a value associated with the article to a dispensing device at a destination that is geographically different from said origin [col. 1 lines 47-52; col. 2 lines 18-23; col. 15 lines 17-24]; and

dispensing at the destination a medium having inherent value [col. 2 lines 43-57 (for example, see card with \$50.00); col. 1 lines 6-14 (currency)].

Re. Claim 2, Brody discloses dispensing the medium at a destination device as legal tender [col. 2 lines 18-28; col. 8 lines 20-36].

Re. Claim 3, Brody discloses dispensing the legal tender of one country that is different from the legal tender of a country of said origin [col. 2 lines 18-28; col. 8 lines 20-36; col. 7 lines 8-13].

Re. Claims 6-8, Brody discloses providing to a user at said origin device a unique identification of a transaction to be carried out between said origin device and said destination device [col. 8 line 67 to col. 9 line 12; col. 11 lines 16-30], and including receiving an input at said destination device by a user thereof said unique identification, and in response to the input of said unique identification at the destination device, dispensing the medium [col. 8 line 67 to col. 9 line 12; col. 10 lines 1-33], and wherein said unique identification includes a transaction number and a personal identification number [col. 8 line 67 to col. 9 line 12; col. 13 lines 35-40].

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Re. Claims 24, 26-27, Brody discloses receiving input information via a touch screen input/output device by a user using said origin device, and encrypting the signals input by the user via the touch screen input/output device [Figure 1, 9; col. 5 lines 38-53; col. 25-30; col. 9 lines 1-11 (see PIN encoded)], including using a printer at said destination device to print said medium [col. 5 lines 38-40], and wherein said dispensing comprises printing said medium [col. 5 lines 38-40; col. 13 lines 45-50].

Re. Claims 28, Brody discloses inserting legal tender by a user into an origin device; determining a monetary value of the legal tender inserted [col. 1 lines 16-24, 57-67; col. 9 line 60 to col. 10 line 8]; electronically communicating to a destination device a monetary value associated with the legal tender inserted into said origin device [col. 1 lines 47-52; col. 2 lines 18-23; col. 15 lines 17-24]; and electronic communication allowing legal tender to be dispensed at the destination device [col. 1 lines 16-22, 57-67; col. 9 line 60 to col. 10 line 8].

Re. Claims 31-32, Brody discloses including providing to the user of the origin device the unique transaction number and a personal identification number and including receiving at said destination device by a user thereof the unique transaction number as a prerequisite to dispensing the legal tender at said destination device [col. 8 line 37 to col. 9 line 12; col. 10 line 8-33].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody.

Re. Claims 9-15, 17-19 Brody discloses ATM cards, Deposit card, withdrawal cards, cash (negotiable instrument and legal tender) [col. 2 lines 43-57], dispensing the medium at said destination device as a card having written thereon a monetary value and including writing the monetary value on a storage medium of a card, and writing the monetary value on a storage medium comprising a magnetic strip [Figure 7 & 8; col. 13 lines 35-38; col. 13 line 67 to col. 14 line 10], including receiving at said origin device a card having stored thereon said monetary value [col. 2 line 44-46 - credit card] capable of storing monetary value. Brody does not explicitly disclose including dispensing the medium at said destination device as a coupon, including dispensing the medium at said destination device as a ticket, including writing the monetary value on a storage medium comprising a chip. However, these are an alternative ways of storing values and are well known (for example, in movie theaters, greyhound bus stops, and airports ticket dispensing machines. ATM machines at the back of the receipts prints valuable

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coupons, and smart cards, IC cards and phone cards, store gift cards are well known). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Brody and include alternative means of storing value cards to allow more customers to use the system and make the system more profitable.

Claims 4-5, 16, 22-23 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody in view of Downing et al (hereinafter Downing – 5,963,647).

Re. Claims 4-5, 16, 22-23 and 29-30, Brody discloses accessing databases [Figure 2; col. 8 lines 1-6; col. 5 line 67 to col. 6 line 6], including receiving at said origin device said article and determining the monetary value associated therewith, subtracting from the monetary value a transaction expense to provide a remainder [col. 1 lines 6-14 (currency); col. 2 line 43-58; col. 3 lines 37-53 – see fees]. Brody does not explicitly disclose including carrying out an exchange rate calculation to define the value of the legal tender of a country of said destination, and including accessing a database to determine an exchange rate, and converting the remainder (balance of an amount after fee) to said medium and dispensing the medium at said destination device, including converting at least a portion of the monetary value of the legal tender inserted in to the origin device to a different legal tender for dispensing at said destination device, and including carrying out said conversion using a foreign monetary exchange rate.

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However, Downing discloses these features [Abstract; figure 5B # S11; col. 6 lines 38-65; col. 7 lines 17-27, lines 44-45; col. 11 lines 27-37; col. 16 lines 57-63] to calculate applicable foreign exchange rate for the currency of the source account and the currency of the selected destination. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Brody and Downing to provide a system for converting value of transfer funds from one currency (local currency) to another currency (foreign currency) at applicable foreign exchange rate to facilitate foreign currency transfer.

Re. Claims 22-23, Brody does not explicitly disclose including electronically transmitting from the origin device a message having a format including at least two variable segments, and a fixed segment having one or more fields defining respective formats of said variable segments, and wherein said fixed segment includes fields defining identification parameters of said origin device, one said variable segment has fields defining a method of payment, and another variable segment has fields defining parameters of a vendor of goods or services. However, Downing discloses these features [Figure 2-3, Figure 4; col. 8 line 45 to col. 9 line 12 – see Figure 4 dates # 45 & # 50, source account # 42, and sender terminal ID are fixed fields. Figure 4 # 41, and recipient's name # 41, destination country # 44, Fees # 47, amount # 48 are variable] to provide a fund transfer system capable of transferring formatted instruction file from origination to destination having variable data segments to satisfy the transfer protocol of the destination device. It would have been obvious at the time the invention was

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made to a person having ordinary skill in the art to combine the disclosures of Brody and Downing to provide a system capable of transferring payment instruction file to different ATM systems over the electronic network.

Claims 20-21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody in view of Randle et al. (hereinafter Randle – US 5,974,146).

Re. Claims 20-21 and 25, Brody discloses transfer money system that allows customer to make bill payments (paying bills) from remote locations using cards [col. 14 lines 15-20]. Brody does not explicitly disclose an electronic message authorizing payment of an invoice, and including transferring the electronic message to a merchant for payment of the invoice, and including using a kiosk terminal as said destination device. However, Randle et al (hereinafter Randle - US 5,974,146) discloses these features [col. 1 lines 42-61; col. 5 lines 1-13, lines 29-37; col. 9 lines 18-22; col. 12 lines 18-47] to provide a real time payment system using ATM, kiosk, etc. which allows customers to pay bill any time. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Brody and include invoice payment (an electronic message authorizing payment of an invoice, and including transferring the electronic message to a merchant for payment of the invoice), as disclosed by Randle, using ATM network for faster service in real time.

Conclusion

Claims 1-32 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628



3/24/06